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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,386	09/27/2001	Eric L. Andersen	10017511-1	2925

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EXAMINER

LEE, DIANE I

ART UNIT PAPER NUMBER

2876

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,386

Applicant(s)

ANDERSEN ET AL.

Examiner

D. I. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-25 are presented for examination.

Claim Objections

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

There are two sets of claims 21-22. Therefore, misnumbered claims 21-22 (the second occurrence) and 23 have been renumbered 23-25.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, 6-7, 9, 12, 15, 19-20, and 22 rejected under 35 U.S.C. 102(b) as being anticipated by Matsukawa [US 5,436,436].

Re claims 1, 6, 12, 20: Matsukawa discloses an IC card terminal apparatus for automatically selecting a language to display on the user interface (the display device of the IC card terminal) in the preferred language of the user, which stored in the portable memory medium, comprising:

a language identification information reading means 81, which connected to the IC card reader 2, 102, for reading a language identifier from a portable memory medium (IC card 1, 101) in which the

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user's preferred language identification information is stored (see the abstract, col. 2, lines 15+; and figures 1, 3);

a memory 104 in the IC card terminal that stores computer executable instruction that the terminal performs the operations of reading, identifying, and selection when the executable instruction is executed by a processor 8, 103 (see col. 2, lines 30+ and col. 3, lines 8+);

a display control means 83 for picking a message corresponding to the language indicated by the language identification information read out by the language identification reading means 81 to cause the display unit to display the message according to the stored language identification information. This clearly teaches the claimed steps of the identifying a preferred language associated with the language identifier and displaying the user interface in the preferred language (see col. 2, lines 28+; col. 3, lines 66+ for example).

Re claim 7: the IC card 1, 101 is configured to be inserted into an interface (an IC card reader/writer 2) of a computer device (the IC card terminal) for effecting identification of an owner of the card. The card includes a memory a, 111 for storing personal data and a language identifier that identifies a preferred language of the card owner (see col. 3, lines 33+).

Re claims 3, 9, 15, 19, and 22: the portable memory card 1, 101 is an integrated circuit card (see figures 1 and 3).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2, 8, 14, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsukawa in view of Akiyama [US 4,736,405]. The teachings of Matsukawa have been discussed above.

Although Matsukawa teaches the portable memory medium is a card having an IC chip as a memory for storing personal data and a language identifier that identifies a preferred language of the card owner; Matsukawa does not teach the portable memory medium is a card having a magnetic strip.

Akiyama teaches a portable memory medium is a card having a magnetic strip, i.e., ID card 203 is a magnetic card (see col. 3, lines 21+).

Since the IC and the magnetic strip in the portable medium such as a card is an art recognized functional equivalent for storing the data, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to recognized that switching the IC technology to the magnetic strip technology in the apparatus of Matsukawa would have been a cost effective transition.

8. Claims 4, 11, 13, 17, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsukawa in view of Akiyama [US 4,736,405]. The teachings of Matsukawa have been discussed above.

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Matsukawa teaches that the system selection of the preferred language is based on the identified data that is stored in the card and the language user interface (display device) can display the message in more than one language. The IC card terminal of Matsukawa provides a variable language of a message for guiding the card user regardless of the terminal location. Therefore, the IC card terminal apparatus of Matsukawa can tailor the language of the message in accordance to the card owner's preferred and/or understandable language for clearly guiding the transaction operation to the card user.

Matsukawa does not teach that the card and the IC card terminal apparatus is an automated teller machine (ATM) and the card is an ATM card.

The fact that the ATM terminal is provided in various location of the world, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the teachings of Matsukawa in the ATM environment, i.e., the card terminal and the user's card being an automated teller machine (ATM) and the card is an ATM card, respectively, such that the display device of the automated teller machine capable of tailoring the language of the transaction message in accordance to the card owner's language preference and/or understandable language for clearly guiding the card user in the transaction operation regardless the location of the ATM terminal. Accordingly, such modification would have been an obvious extension taught by Matsukawa. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed and does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 164 (1987).

9. Claims 5, 10, 16, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsukawa in view of Abe et al. [US 5,895,903]. The teachings of Matsukawa have been discussed above.

Re claim 23: Matsukawa does not teach the IC card terminal displaying the user interface in a default language in the event that the user interface cannot be displayed in the preferred language.

Abe teaches the IC card terminal selecting an alternative language of the transaction message, i.e., displaying a default language, when the IC terminal cannot be display in the preferred language due to the preferred language is not identified by the user (see col. 7, lines 26-26 and figure 18).

Therefore, it would have been an obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the system of Matsukawa to provide the IC card terminal displaying a default language as an alternative, as taught by Abe, in the event that the user interface cannot be displayed in the preferred language when the preferred language is not identified on the card. Accordingly, such modification would allow the card user to carry the transaction without the preferred language identification information. Therefore, it would have been an obvious extension taught by Matsukaw.

Re claims 5, 10, 16, and 26: Matsukawa as modified by Abe does not teach the language identifier having a primary language identifier and a secondary identifier such that the card terminal displaying the user interface in a preferred language indicated by the secondary language identifier in the event that the preferred language indicated by the primary language identifier is unavailable.

However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to expand the user's identification data to include the secondary preferred language in the language identification section of the card in addition to the primary preferred language, so that the terminal can most identifies and accommodates the user's preferred language when the user's first preferred language is not a popular language. Such modification would also prevent the possibility, which the default language of the terminal may not be an understandable language to the user. Therefore, it would have provides an apparatus that selects the most appropriate and comfortable language suitable

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to the card user. Accordingly, it would have been an obvious extension taught by Matsukaw as modified by Abe.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Tarbox [US 5,705,798], DeBan [US 5,386,103], Anderson et al. [US 4,848,304], Arsenault [US 5,787,406], Hollis [US 6,149,057], Mori [JP 58-082,365 A], Lee [WO 95/20859], Suzuki [JP 04-286,582 A], and Nakashige [JP 200132610 A] discloses ATM terminal or a card terminal similar to applicant's claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is 703-306-3427. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



D. I. Lee
Primary Examiner
Art Unit 2876

D. L.
May 15, 2003